

REMARKS

The Office Action dated 03/01/2004 (hereinafter referred to as the OA) has been received, and its contents carefully studied. Applicant presents this response and amendment which Applicant believes to be fully responsive to the OA. Applicant, in the interest of making progress in the general prosecution of the pending application, has made various amendments to claims and has cancelled some claims. Applicant reserves the right to re-present material unless explicitly disclaimed by Applicant herein in future correspondence with the US Patent Office.

Claims Rejections Under 35 USC § 102

Independent claims 134, 135, 137, 138, 139, 147, 151 and 152 have been rejected as anticipated by Weiss (US Patent 6,165,071).

Weiss does not teach each of the limitations found in the presently pending independent claims. First, applicant will address the limitation of being a gaming device. Applicant was confused by the OA (see below); but notes that Applicant may have misunderstood the Examiner's rejection language.

It appears to Applicant that the OA initially acknowledges the gaming device limitation found in each independent claim (OA page 2, last full sentence "Weiss also

discloses that a memory card can hold data regarding use in specific machines, such as a machine exclusively calibrated for baseball (4:53-58), which also meets the limitation of a gaming device restriction"), the rejection being applied to all the pending independent claims. However, in the 103 rejection the OA disavows the gaming device limitation for independent claims 134, 135, 137, 138, 139, and 151 (OA, first full sentence on page 4, "In response to applicant's arguments, the recitation 'configured to enable play of a game whose outcome is based at least partially on a random event' has not been given patentable weight"). Applicant will respond as best and as completely as Applicant can given the apparently differing stances on the gaming device limitation.

First, Applicant respectfully disagrees with the statements in the OA about the previously pending claims' use of structural limitations in the preamble. The limitation to gaming devices in the preamble ("...configured to enable play of a game whose outcome is based at least partially on a random event ...") is a restriction on the claims, as shown by the preamble language quoted in the OA ("... configured to ..."). "Configured to" is a structural limitation, not a mere recitation of a goal of the method claims. An example of language that is not a limitation would include words that discuss a possible use, a hoped-for result, or a recitation of an end result of the method rather than a structural configuration, such as "A gaming device that uses newprom awards, the gaming device comprising ..." or "... A method that improves player interactions at a gaming device using newprom awards, the method comprising ..." or other language that does not restrict the device being described. Applicant's language was not that; "configured to" to is not a result of a method, it is a limitation on the device used with the method.

The OA quoted case law which is found in the MPEP dealing with patentability, Chapter 2100. One case was *Kropa v. Robie* found in §2111.02, a section specifically dealing with limitations found in preambles. It was used for the statement that a "... preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim ..." The other case, *in re Hirao*, is found in section §2141.02 which generally deals with the difference between the prior art and the claimed invention under a 103 rejection, and was used, as far as Applicant can determine, for the language that (language taken from MPEP §2141.02) "... The preamble only recited the purpose of the process and did not limit the body of the claim." Applicant respectfully submits that the previously pending claims which used the "configured to" phrase in the preamble were not "merely reciting a property" (*Kropa v. Robie*) nor "reciting the purpose of the process" (*in re Hirao*). Rather, the wording "configured to" is a clear structural limitation on the configuration of the claimed gaming device.

Applicant respectfully wishes to avoid time-consuming and expensive (for the Applicant) arguments on the form of pending claims, however, so Applicant has amended each independent claim that previously had the "configured to" limitation in the preamble to now have a gaming device limitation in the body of the claim.

Independent claims 134, 135, 137, 138, 139 and 151 now have, in the claim body rather than the preamble, "providing at least one game on said device whose outcome is at

least partially determined by a random event". Independent claims 147 and 152 had a similar limitation in the body of the claims previously: "having at least one game whose outcome is at least partially determined by a random event". Thus, all presently pending independent claims now have the limitation of being applicable only to devices having a game of chance in the body of the claim. Applicant believes this element is not found or taught in Weiss, in addition to other functional differences.

The OA asserted that games based on sports are games of chance by saying "... However, Examiner is of the mindset that wagering on sports games is, in fact, wagering on random events. The nature of sports, while relying on individual's abilities or that of a group, does not detract from the unpredictability of the outcome. The game's unpredictability lends to the randomness of the apparent outcome ... A player in Weiss can wager on all aspects of a sports game (2:16-37), which would be a game based on the random occurrence of events." Applicant appreciates the time spent by the Examiner to give the explanation and appreciates the opportunity to respond.

The intent of Applicant is cover games that are traditionally viewed as games based entirely on chance (i.e., reel games) or at least partially on chance (i.e., any video card game, where the cards given to a player are in random order). Applicant is glad to put this understanding (and therefore a limitation which will be read into the claims in the form of disclaimed material) on the record. There are many games, and variants of games, based at least partially on chance which Applicant does wish to include in the claims coverage. Applicant wishes to note that the distinction is in the source of the

unpredictability from the bettors' viewpoint. As pointed out by the Examiner, betting on a sports game has an unpredictable aspect because a person making a wager cannot control or predict individual or team play as the game progresses (if this were not the case, then no one would bet on any games... and no one would even be a spectator! since the outcome would always be known). However, being unpredictable is not the same as the limitation of being at least partially determined by a random (chance) event. The random or chance event being referenced in the claims is the traditional usage found in the gaming arts: a purposefully generated random event upon which game outcome partially (card games) or fully (dice, reels) depends. It is not an unpredictable event like the outcome of each foul shot in basket in basketball; rather, the event itself is a random event.

Put differently, a random or chance event is unpredictable, but the source of the unpredictability is not the same as that in a sports game. Each player action in a sports game is not determined by a random event, even though the net effect on a bettor is that the outcome is unpredictable. In a gaming device, the unpredictability arises out of the use of events which are, in and of themselves, random or chance events. Certainly a random event therefore means the result of each game is unpredictable to a bettor; however the converse does not follow, where the converse is the proposition that all unpredictable games must therefore arise out of the use or perceived use of a random event.

A random event is an event that is designed to be, in itself, as random as mathematically or pragmatically possible, such as the throw of a die or a shuffled deck of cards (in table games), or the random number generator (RNG) used in most gaming machines. The RNG generates series of random numbers which are used (mathematically) as the basis, or used to determine, the game outcomes. This is the limitation Applicant is addressing. This is not the same as unpredictability based on an unknown outcome of specific purposeful actions of individuals playing sports games. In the later case, there is no specific random event being used as the basis for game outcome.

Applicant also changed the wording in independent claims 134, 135, 137, 138, 139 and 151 to be "...one game ... whose outcome is at least partially *determined* by a random event ...", where previously it has been worded as "based on". Applicant is trying to be clear that each game outcome is at least partially determined by (uses) a random event to determine the game results. That is not the same as having unpredictability; all games must be unpredictable or there would be no reason to play them (they would be immediately boring). Such games, however, do not use a specifically cognizable random event to determine game results.

Applicant wishes to note for the record that although the current generation of gaming devices use RNGs for the generation of random events, there are other technical methods of generating random events which may be used in future gaming devices; any method of generating random events usable for at least partially determining game results are included.

An example of another set of games that are excluded by the limitation of being at least partially determined by a random event are skill-based games, typically found in arcades. Such games have outcomes that are unpredictable to players, but are not based on random events.

To the best of Applicant's knowledge, Applicant is using the words in the claim limitation as normally understood by persons skilled in the gaming arts. Applicant is more than willing to discuss alternate wording with the Examiner to express the concept of a game being based on a random or chance event, as expressed herein, if the Examiner still believes the presently pending words do not express the intended limitation well enough. Applicant believes that the wording of the pending claim limiting the gaming devices to ones which must have a game whose outcome is at least partially determined by a random event is a very clear limitation which does not include games whose outcome does not use a random event (even though the outcome may be unpredictable to a bettor or player). Wording suggestions expressing the concept of a game whose outcome is based on a random event (which leads, by definition, to unpredictable results but does not lead to the conclusion that all unpredictable games are therefore based on the use of a random event) would be gladly entertained.

In conclusion, Weiss does not disclose the limitation of a game based on a random event (even though the game output may be unpredictable to the bettor), as Applicant is

using the words herein. For this reason alone, Applicant believes Application has shown the presently pending claim set is not anticipated by Weiss.

Applicant also notes that there are other elements and functional relationships found in the presently pending claims not taught by Weiss, such as the fact that Weiss teaches a sports game that can be left, data saved, and then restarted later by the player. This is not the same set of elements and functional relationships as found in the pending claim set, which are based on the gaming device enhancements or restrictions, including time restrictions, location restrictions, gaming device restrictions, game play enhancements, or, award level enhancements. Weiss teaches the ability to continue game play of an on-going game. The present invention claims the ability to use promotional awards with limitations attached. The presently claimed invention does not claim or go towards the continuation of an on-going game; each game is finished by a player at each game play session (not continued, as in Weiss). What is carried forth is any existing promotional game credits and their relationship to how the game device is played.

Applicant doesn't believe the claims limitations dealing with gaming activity restrictions and enhancements of the presently pending claims are disclosed by Weiss, and notes these are additional reasons Weiss does not anticipate the pending claims.

Claims Rejections Under 35 USC § 103

Each pending independent claim (134, 135, 137, 138, 139, 147, 151 and 152) was further rejected under 35 USC §103 as being unpatentable over Weiss. Applicant has amended independent claims 134, 135, 137, 138, 139, and 151 by moving the limitation of being a gaming device having at least one game whose outcome is determined by a random event from the preamble to the body of the claims, as explained in the section addressing the 35 USC §102 above:

The rejection of independent claims 134, 135, 137, 138, 139, and 151 was based on the idea of ignoring the gaming device limitation (OA, page 4). Applicant addressed and traversed this issue as explained in the section discussing the 35 USC §102.

As far as Applicant can determine, independent claims 147 and 152 were rejected based on the statement made in the first paragraph of page 5 of the OA. The basis of the rejection was "Examiner has pointed to a particular location in Weiss that discloses at least one data element of a gaming device restriction." Applicant went back through the OA and found the following references (cites) in Weiss, with summaries of how the cite is being asserted against Applicant:

1. Play a game over many sessions (Abstract)
2. Discontinue game play at player's discretion as a function of time (1:59-67)
3. Hold game state data with player information (2:25-37)
4. Used later when restoring a game (2:25-37)
5. Data as described above for a specific machine, such as a baseball machine (4:53-58)
6. Variable states of identified game elements for analysis (2:15-19; 5:30-58)

7. Players can wager on any element of a sports game (2:16-37)

The text referenced by the above cites are as follows:

- 1: A method and apparatus which allows player gaming to transpire over a series of sessions without a player losing credit for performances in earlier sessions. A player card carries thereon the current status of the player's performance during the course of previous sessions and it updated during subsequent sessions. Milestones are recognized as opportunities for providing the player with awards as these milestones are achieved.
- 2: The instant invention is distinguished over the known prior art in a multiplicity of ways. For one thing, the instant invention allows the player the opportunity to initiate play or discontinue play at his own whim as a function of time over a series of sessions. Equally as important, however, is the ability to provide the player with a game format in which the incentive to continue play over a protracted period of time includes milestones as a function of performance in the underlying game itself.
- 3: In a preferred form of the invention, these desiderata can be achieved by providing a gaming machine, a player card having a memory integrally formed therewith and means for reading information contained on the player memory card. The player memory card provides an up to the minute encapsulation of the player's status during the course of play and is updated at the end of each playing session. When play has progressed for a protracted period of time, again at the player's discretion, supplemental awards are available to the player as the result of progress based on milestones established for the particular game. This allows the player to redeem credits directly correlated to performance as a function of time during the plural sessions comprising the simulative event.
- 4: Same as 3 above.
- 5: The machine receives a signal from the card 20 announcing the type of game the player expects to play. Alternatively, and preferably the machine may be "single purpose" machines in which the player must take a baseball card and correlate it with a machine that is exclusively calibrated for baseball.
- 6: First cite: Comparative records of multiple players engaged in similar sport games could form a comparative award based on team performance, player performance or the establishment of new player records heretofore unattained. Examples include most yards gained rushing, highest free throw percentage, longest home run, fastest lap time, most hat tricks scored, best team record, best earned run average, and the like. (New Paragraph) In a preferred form of the invention, these desiderata can be achieved by providing a gaming machine, a player card having a memory integrally formed therewith and means for reading information contained on the player memory

card. The player memory card provides an up to the minute encapsulation of the player's status during the course of play and is updated at the end of each playing session. When play has progressed for a protracted period of time, again at the player's discretion, supplemental awards are available to the player as the result of progress based on milestones established for the particular game. This allows the player to redeem credits directly correlated to performance as a function of time during the plural sessions comprising the simulative event.

Second Cite: If the card status coincides with an award in which there are no residual benefits, an award is made and in one form of the invention the card can be retained by the machine. On the other hand, the bonus could be awarded with the card decremented and updated and returned to the player with an update so that any surplus remaining on the card can be utilized for further play by the player. If the player merely request a status report with respect to the player performance vis a vis other criteria, the update is provided on the screen 120 and then the card is returned to the player for further play. It could be that a game in progress has milestones that allows the performing player to receive incremental awards as a function of play. Thus, the portion which earns an award can be harvested by the player through outlet 180 as desired. (New Paragraph) Assume that the game simulation is baseball. The player memory card should be capable of storing data at least with respect to the player's performance both by inning, by game, by season and by post season competition. In addition, pitching and batting performance for the player can be stored on the card for subsequent analysis to award benefits to the player as a function of having achieved milestones. For example, selection to an all star team during the course of the season may make the player eligible for bonus awards during an intermediate portion of the season. Similarly, most valuable player awards can be determined post season and during a play off. This information is stored on the player memory card at the end of each gaming session and is downloaded into the machine 10 prior to the next play by the player.

7: Comparative records of multiple players engaged in similar sport games could form a comparative award based on team performance, player performance or the establishment of new player records heretofore unattained.

Examples include most yards gained rushing, highest free throw percentage, longest home run, fastest lap time, most hat tricks scored, best team record, best earned run average, and the like. (New Paragraph) In a preferred form of the invention, these desiderata can be achieved by providing a gaming machine, a player card having a memory integrally formed therewith and means for reading information contained on the player memory card. The player memory card provides an up to the minute encapsulation of the player's status during the course of play and is updated at the end of each playing session. When play has progressed for a protracted period of time, again at the player's discretion, supplemental awards are available to the player as the result of progress based on milestones established for the particular game. This allows the player to redeem credits directly correlated to performance as a

function of time during the plural sessions comprising the simulative event.

The presently claimed invention is not disclosed or taught by the cites (or, Applicant believes, anywhere in Weiss). Although there are more reasons, one aspect of the currently pending claims not taught or disclosed in Weiss includes:

- (i) each of the presently pending independent claims includes the limitation of being a game device having a game thereon whose game play results are based on a random event (as discussed above this limitation is not the same as being unpredictable to a player or bettor; all games have some aspect of being unpredictable to users or viewers of the game, what differs between games played is the source of the unpredictability); and
- (ii) each of the presently pending independent claims includes the limitation of having at least one of a: time restriction, location restriction, gaming device restriction further configurable to only enable play on a subset of gaming devices on which said neweprom data is otherwise usable, game play enhancement, or, award level enhancement; as these are usable in a gaming device having the limitation found in (i) above.

Weiss does not teach about gaming machines as claimed herein (have a game whose outcome is based on the use of an explicit random event); further, Weiss does disclose the claimed restrictive or enhancing gaming device elements. As nearly as applicant can determine, the Examiner is asserting against Applicant that Weiss discloses a "time restriction" in cite 2 and a gaming device restriction in cite 5. Arguendo, setting aside the fact that Weiss does not teach a game based on a random event, cite 2 (see cite language above) discloses a sports-based game that extends over a plurality of individual game sessions. The ability to continue a game over a plurality of sessions (where each

session may occur at a different time) is not what is being claimed in the presently pending claim set. Cite 2 (and elsewhere in Weiss) addresses the ability of a player of an on-going sports game (extending, perhaps, over a "season" of a sport like baseball) to continue play over an extended period of time. To do that, a player needs to have the ability to discontinue and then restart their games. Applicant agrees that Weiss discloses a device having the ability to allow a player of a sports-game to stop and then re-start. That is not what is being claimed in the presently pending claims. For example the pending claims all include, as one possible game device limitation, a time restriction. A time restriction is specifically counter to the idea of enabling a player to stop and re-start a game at the player's whim (see cite 2 above). A time restriction restricts the ability of a player to make use of specified promotional awards to specific times, as indicated by the word "restriction" and as explained in the disclosure of the present invention. Applicant cannot see how the idea of allowing a player to restart a sports-game at the player's whim (cite 2) teaches what Applicant is claiming, which is the opposite idea: that of the time restriction (and further on the use of that time restriction on a gaming device which uses a random event for game results). Therefore, Applicant respectfully disagrees with that assertion, and traverses it for the reasons given in this section as it was made against the previously pending claims and as against the presently pending claims. The gaming machine restriction has been amended to more clearly claim what Applicant believes to be the invention, which allows casinos to enable or disable use of the promotional awards or credits down to the granularity of specific machines, banks of machines, or other criteria which is not based on data compatibility as expressed in Weiss. For at least this reason, Applicant traverses any rejection based on gaming machine restrictions as arguably

taught by Weiss (Applicant is addressing a single element; Weiss does not teach the combination of elements found in the pending claim in any case).

Applicant again reviewed Weiss and cannot find teachings that include at least the elements described and in the combination as presently claimed. Applicant traverses the OA rejections thereby, for at least those reasons.

CONCLUSION

The applicant believes this response to the OA is fully responsive and puts the application into condition for allowance. Applicant respectfully requests consideration for allowance thereby. Please feel free to contact the undersigned attorney with any questions or clarification regarding this matter.

Respectfully submitted,

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